



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Kind of application of:

Carl J. Ledbetter, et al.) Group Art Unit: 2673
Appln. No.: 10/760,466) Examiner: Lao, Lun Yi
Filed: January 21, 2004) Atty. Docket No.: 03797.00717
For: INPUT DEVICE INCLUDING A WHEEL ASSEMBLY FOR SCROLLING AN IMAGE IN MULTIPLE DIRECTIONS

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Sir:

Applicants hereby request a pre-appeal review prior to filing of an appeal brief pursuant to the Pre-Appeal Brief Conference Pilot Program published in the Official Gazette, July 12, 2005. This paper is being filed concurrently with a Notice of Appeal. No amendment is filed with this paper.

The Examiner's rejections are based on clear error

The Examiner rejects claims 13-15 under 35 U.S.C. § 102(b) over Naoyuki (JP 2000-200147), claim 16 under 35 U.S.C. § 103(a) over Naoyuki, claims 1-12 and 17-20 under 35 U.S.C. § 103(a) over Pruchniak (U.S. Pat. No. 6,075,518) in view of Naoyuki. These rejections are based on clear error as set forth below.

Claim 13 and dependent claims 14-16 recite an electronic input device comprising a scroll wheel that is pivotably displaceable relative to the housing to cause scrolling of an image in a direction perpendicular to a first direction. The Office Action asserts that Naoyuki discloses a scroll wheel 202. However, the scroll wheel 202 of Naoyuki is not pivotable and does not cause scrolling of an image in a direction perpendicular to the first direction. The Office Action

further asserts Naoyuki discloses a stick 212. However, the stick 212 of Naoyuki is not a scroll wheel (see figures 5(A)-5(C) and paragraphs 011-0012 of translation). Claims 13-16 also recite that the scroll wheel is rotatable. The stick 212 of Naoyuki does not rotate (see arguments already of record, Request for Reconsideration filed September 26, 2005, page 2). Thus, the rejection of claim 13 is based on clear error.

The Examiner rejects claims 1-12 and 17-20 under 35 U.S.C. § 103(a) over Pruchniak (U.S. Pat. No. 6,075,518) in view of Naoyuki (JP 2000-200147).

Claim 1 and dependent claims 2-8 recite a moving sensing system configured to sense pressure applied to a rotatable member for the pivotal movement. The Office Action asserts that Pruchniak discloses a control arm (40) and microswitches 34. However, neither the control arm nor the microswitches senses pressure applied to a rotatable member for pivotal movement. Rather, these elements merely result in a selection.

The Office Action asserts that Pruchniak discloses “sensing pressure(d) applied to the rotating member” (final office action, page 6) at column 3, lines 11-68 and col. 4, lines 1-26. However, contrary to the Office Action’s assertion, there is no such disclosure at col. 3, lines 11-68; col. 4, lines 1-26; or anywhere else in Pruchniak.

The Office Action asserts that Pruchniak discloses “sensor (34) for detecting the lateral pressure applied to the scrolling wheel (50)” (see Final Office action, page 7 citing Pruchniak, col. 3, lines 36-45). However, the so-called “sensor(34)” is actually not a sensor at all but a “microswitch (34)”. Moreover, contrary to the Office Action’s assertion, microswitch 34 does not detect “the lateral pressure applied to the scrolling wheel (50)” as the Office Action attempts to assert. See arguments already of record, Request for Reconsideration filed September 26, 2004, page 3.

Naoyuki discloses a stick 212 (FIG. 5(A)-5C)) that is not rotatable. Also, stick 212 of Naoyuki is not configured to sense pressure applied to a rotatable member for pivotal movement. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggest by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The combination of Pruchniak and Naoyuki fails to teach or suggest all the claim features. Therefore, the rejection is based on clear error. See arguments already of record, Request for Reconsideration filed September 26, 2005, page 3.

Claim 9 and dependent claims 10-12 recite sensing relative changes in lateral pressure applied to the rotatable member. Pruchniak discloses microswitches to result in a selection. Naoyuki discloses scroll buttons 602 (FIGS. 9(A)-9(C)). However, neither Pruchniak nor Naoyuki, either alone or in combination, teaches or suggests sensing relative changes in lateral pressure applied to the rotatable member. See arguments already of record, Request for Reconsideration filed September 26, 2005, page 4.

The Office Action asserts that Naoyuki discloses “sensing relative changes in lateral pressure applied to a scrolling member” at FIG 9-11 and paragraphs 39-45 – Final Office Action, page 7. However, contrary to the Office Action’s assertion, there is no such disclosure in the FIGS; in paragraphs 39-45; or anywhere else in Naoyuki. The Office Action merely cites specific paragraphs in Naoyuki and asserts that the cited paragraphs contain the alleged disclosure. Because the cited paragraphs in fact do not contain the alleged disclosure, the Office Action has failed to establish *prima facie* obviousness.

In addition, there is no motivation to modify Pruchniak with Naoyuki or vice versa. The Office Action asserts the motivation to combine the references is 1) because “they both teach scrolling … devices” and 2) to “provide a … device for users to scroll images … in any direction as they want.” See Final Office Action, page 4. Regarding the former, two references pertaining to the general field of input devices is insufficient, without more, to provide a motivation to combine. In the present case, Pruchniak discloses a scroll wheel and Naoyuki discloses a stick. There is no motivation to modify a scroll wheel with a stick merely because they are both input devices. Regarding both the alleged motivations, obviousness requires that “particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the matter claimed.” *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). See arguments already of record, Request for Reconsideration filed September 26, 2005, page 5.

Claim 17 and dependent claims 18-20 recite a sensor for sensing lateral movement of the rotatable member including at least one linear extendable member … so as to provide a rate of change of the lateral movement. Neither Pruchniak nor Naoyuki, either alone or in combination, teaches or suggests a linear extendable member to provide a rate of change of the lateral movement. The Office Action fails to address this deficiency in the combination of Pruchniak and Naoyuki. Rather, the Office Action argues that “Naoyuki teaches a scrolling input device for

controlling the scrolling speed by sensing the pressure applied to the input device” and that it would somehow have been obvious to modify Pruchniak “since to apply pressure on a scrolling device to control scrolling speed is more easy and precise than to use scrolling wheel rotation speed.” See Final Office Action, page 5.

First, claim 17 does not recite “sensing the pressure” as the Office Action appears to assume. Rather, claim 17 recites a linear extendable member to provide a rate of change of the lateral movement of the rotatable member. This feature is missing in both Pruchniak and Naoyuki. Secondly, the Office Action further asserts that it is supposedly easier and more precise to “apply pressure” than to measure rotation speed. This has nothing to do with the recitation of a linear extendable member or a rate of change of the lateral movement. To the extent that the Office Action assumes “rate of change” is somehow related to “speed”, the Office Action also concludes that it is somehow better not to measure speed. Therefore, the Office Action appears to be asserting that the combination of Pruchniak and Naoyuki would have taught away from the claimed invention. Thus, the Office Action appears to agree that there would have been no motivation to combine Pruchniak with Naoyuki. In any event, the Office Action rejects claim 17 (and dependent claims 18-20) but provides no rationale for the rejection. This is improper.

Conclusion

For the foregoing reasons and arguments of record, the rejection of claims claims 13-15 under 35 U.S.C. § 102(b) over Naoyuki (JP 2000-200147), claim 16 under 35 U.S.C. § 103(a) over Naoyuki, claims 1-12 and 17-20 under 35 U.S.C. § 103(a) over Pruchniak (U.S. Pat. No. 6,075,518) in view of Naoyuki should be withdrawn as clear error. It is respectfully submitted that this application is in condition for allowance and that the rejections should be withdrawn. If any additional fees are required or if an overpayment has been made, the Commissioner is authorized to charge or credit Deposit Account No. 19-0733.

Respectfully submitted,

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For


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